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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92053426
Party	Plaintiff Bachmann Industries, Inc.
Correspondence Address	ROBERTA JACOBS MEADWAY ECKERT SEAMANS CHERIN MELLOTT LLC 50 SOUTH 16TH STREET, TWO LIBERTY PLACE 22ND FLOOR PHILADELPHIA, PA 19102 UNITED STATES RJacobsMeadway@eckertseamans.com, MBoesenhofer@eckertseamans.com, JBae@eckertseamans.com; blabutta@eckertseamans.com
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Date	06/26/2012
Attachments	BACHMANN'S RESPONSE IN OPPOSITION TO SCIENTIFIC'S MOTION TO PRECLUDE (M1055920).PDF (22 pages)(641697 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

BACHMANN INDUSTRIES, INC.,	:	
Petitioner,	:	
v.	:	Cancellation No.: 92053426
SCIENTIFIC TOYS, LTD.,	:	
Respondent.	:	

**PETITIONER'S RESPONSE IN OPPOSITION TO
RESPONDENT'S MOTION TO PRECLUDE**

Petitioner Bachmann Industries, Inc. ("Petitioner" or "Bachmann"), through its undersigned counsel, opposes the Motion to Preclude [Dkt. 36] filed by Respondent Scientific Toys, Ltd. ("Respondent" or "Scientific"), and submits the following information and arguments in support of its opposition.

**I. Bachmann's Initial Disclosures and Pretrial Disclosures
Are Timely and Proper.**

On April 1, 2011, Bachmann served its Initial Disclosures, identifying one witness (i.e., Douglas Blaine, Bachmann's Vice President of Marketing) and several categories of documents and things having or containing discoverable information that Bachmann may use to support its claims or defenses. (A copy of Bachmann's Initial Disclosures is attached as Exhibit A.) Bachmann's Initial Disclosures were proper under Fed. R. Civ. P. 26(a)(1) and 37 CFR § 2.120(a), as well as TBMP §402.02, which states that Bachmann was under no obligation to disclose the name of every witness, document or thing that may have or contain discoverable

information about its claim or defense, but merely those witnesses and documents and things having or containing discoverable information that Bachmann may use to support its claims or defenses. *See also Jules Jurgensen/Rhapsody Inc. v. Baumberger*, 91 USPQ2d 1443, 1444 n.1 (TTAB 2009) (“A party need not, through its mandatory initial disclosures, identify particular individuals as prospective trial witnesses, per se, but must identify ‘each individual likely to have discoverable information that the disclosing party may use to support its claims or defenses.’”). Bachmann served its Supplemental Initial Disclosures on June 20, 2012, in order to identify two additional witnesses (i.e., Edwin Winter, Bachmann’s CFO; and Jeff Troy, a third party) that it might use to support its claims or defenses.¹ *See Spier Wines (PTY) Ltd. v. Shepherd*, Oppositions Nos. 91182155 and 91182825 (TTAB June 12, 2012) (discussing that a potential witness could have been identified in supplemental initial disclosures).

On June 20, 2012, Bachmann served its Pretrial Disclosures, identifying three witnesses (i.e., Mr. Blaine, Mr. Winter, and Mr. Troy) from whom it expects to take testimony, and five additional witnesses (i.e., Scientific’s officers) from whom it may take testimony. Bachmann also provided a general summary or list of subjects on which the witness is expected to testify, and a general summary or list of the types of documents and things which may be introduced as exhibits during the testimony of the witness. (A copy of Bachmann’s Pretrial Disclosures was attached to Scientific’s Motion to Preclude.) Bachmann’s Pretrial Disclosures were proper under Fed. R. Civ. P. 26(a)(3) and 37 CFR § 2.121(e), as well as TBMP 702.01, which states that Bachmann must disclose the name and contact information of each witness from whom it intends to take testimony. *Jules Jurgensen/Rhapsody Inc.*, 91 USPQ2d 1443 (noting that the purpose of

¹ Scientific also supplemented its Initial Disclosures after the close of discovery, on June 14, 2012, to identify four additional witnesses that it might use to support its claims or defenses.

pretrial disclosures is to “allow parties to know prior to trial the identity of trial witnesses, thus avoiding surprise witnesses.”).

There is no rule that a party’s pretrial disclosures must mimic its initial disclosures. *Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1326 (TTAB 2011) (because an exhaustive search for all information or potential witnesses is not required, Board did not exclude the testimony of certain witnesses named for the first time in pretrial disclosures based on the failure to name them in initial disclosures). The fact that Mr. Winter and Mr. Troy were not identified in Bachmann’s Initial Disclosures on April 1, 2011, is therefore immaterial, and insufficient to prevent Bachmann from taking their testimony depositions.

A. Bachmann Should Be Allowed to Take the Testimony Deposition of Edwin Winter

Scientific argues that Bachmann should not be allowed to take a testimony deposition of Mr. Winter because Scientific did not take a discovery deposition of Mr. Winter. Scientific had the opportunity to depose Mr. Winter during discovery, and was not prevented from doing so by Bachmann. Mr. Winter was known to Scientific during discovery, having been identified by Bachmann at least as early as July 18, 2011, in response to Scientific’s First Set of Interrogatories, Response No. 2(c) and (d). (Copies of relevant portions of Bachmann’s Interrogatory Responses attached as Exhibit B.) Scientific in fact initiated a line of questioning about Mr. Winter and his duties during its discovery deposition of Bachmann’s corporate representative, Douglas Blaine, on October 26, 2011. During the deposition, Mr. Blaine advised that Mr. Winter is the senior vice president of finance, is responsible for Bachmann’s financials, and is involved in trademark enforcement activities, including involvement in the instant proceedings. Deposition of Bachmann’s Corporate Representative Douglas Blaine, October 26, 2011 (“*Blaine Depo*”), Page 11, Lines 2-22; Page 109, Lines 11-25, Page 110, Lines 1-25.

(Copies of relevant portions of the Blaine Depo attached as Exhibit C.) *Galaxy Metal Gear, Inc. v. Direct Access Technology, Inc.*, 91 USPQ2d 1859, 1861 (TTAB 2009) (there is no obligation to provide supplemental or corrective information that has been otherwise made known to the parties in writing or during the discovery process). Despite its knowledge of Mr. Winter and his position at Bachmann, Scientific chose not to depose him during discovery. Its decision should not limit Bachmann's trial testimony.

Mr. Winter is not being presented in order to present testimony that will surprise or shock Scientific, or that will require any additional discovery in these proceedings. Mr. Winter is expected to testify with respect to some of the same general topics as Mr. Blaine, as well as with respect to Bachmann's sales and licensing activities, and the documents and things that are expected to be introduced as exhibits during Mr. Winter's testimonial deposition are those that have already been produced in discovery in these proceedings. Scientific will in no way be prejudiced or otherwise harmed if Bachmann is allowed to take the testimony deposition of Mr. Winter.

B. Bachmann Should Be Allowed to Take the Testimony Deposition of Mr. Jeff Troy

Mr. Troy was not yet known to Bachmann at the time it served its Initial Disclosures on April 1, 2011. *See Great Seats Inc.*, 100 USPQ2d 1323, 1326 n.5 (noting that a party may have to disclose the identity of a witness when making initial disclosures *if* the identity of the witness is known when initial disclosures are made). As soon as practical after Bachmann became aware of Mr. Troy and his knowledge of Bachmann and the industry, and the possibility that he would become a trial witness, then Bachmann timely and properly served its Supplemental Initial Disclosures to identify Mr. Troy. Mr. Troy was also timely and properly identified in Bachmann's Pretrial Disclosures.

Mr. Troy is not being presented as an expert witness, but rather as a non-party witness with personal knowledge of the toy train industry, generally, and Bachmann's marks and activities within that industry, specifically. Bachmann is not aware of Mr. Troy having testified as an expert in any other proceedings; he has not conducted any surveys or reports in these proceedings; and he is not being paid for his testimony here. *See* Fed.R.Civ.P. 26(a)(2)(b) (listing the items that must be contained in an expert's report). Mr. Troy is not expected to rely on any special facts or data for his testimony; in fact, the only documents and things that are expected to be introduced as exhibits during Mr. Troy's testimonial deposition are those that have already been produced in discovery in these proceedings.

II. It Is Premature to Deny Bachmann the Right to Take the Testimonial Depositions of Edwin Winter and Jeff Troy

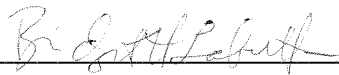
Scientific's requested relief – to preclude the testimony of Mr. Winter and Mr. Troy – is premature because Bachmann has not yet noticed any testimonial depositions. If Scientific considers Bachmann's Supplemental Initial Disclosures or Pretrial Disclosures to be insufficient, then "judicial economy is best accomplished by...a motion to strike..." *Spier Wines (PTY) Ltd.*, Oppositions Nos. 91182155 and 91182825 (TTAB June 12, 2012). Even if Scientific's motion is considered a motion to strike, it must be denied because Scientific has failed to articulate any reasonable legal grounds for striking Bachmann's Supplemental Initial Disclosures or Pretrial Disclosures. Further, if and when Bachmann notices the testimonial depositions of Mr. Winter and Mr. Troy, such notices will be effective and not subject to a motion to quash, since both witnesses were timely and properly identified in Bachmann's Pretrial Disclosures.

III. Conclusion

Scientific's motion to preclude the testimony of Mr. Edwin Winter and Mr. Jeff Troy should be DENIED.

Respectfully submitted,

Date: June 26, 2012

By: 

ROBERTA JACOBS-MEADWAY, ESQ.
JAY K. MEADWAY, ESQ.
BRIDGET HEFFERNAN LABUTTA, ESQ.
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Philadelphia, PA 19102
Phone: 215-851-8522
E-Mail: rjacobsmeadway@eckertseamans.com

ATTORNEYS FOR PETITIONER

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Petitioner's Response in Opposition to Respondent's Motion to Preclude was served on the attorney of record in this matter via electronic mail and FedEx on the date indicated below.

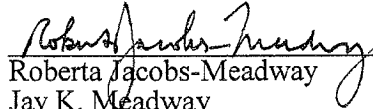
Chester Rothstein
Neil Zipkin
Amster Rothstein & Ebenstein LLP
90 Park Avenue
New York, NY 10016
crothste@arelaw.com
nzipkin@arelaw.com

Date: June 26, 2012

By: 

EXHIBIT A

3. There is no relevant insurance coverage



Roberta Jacobs-Meadway

Jay K. Meadway

Jessica Bae

ECKERT SEAMANS CHERIN & MELLOTT,
LLC

Two Liberty Place

50 S. 16th Street, 22nd Floor

Philadelphia, PA 19102

(215) 851-8522

Attorney for Opposer

Date: April 1, 2011

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Opposer's Initial Disclosures was served on counsel for applicant in this matter via electronic mail and First Class United States Mail on the date indicated below.

Chester Rothstein
Amster Rothstein & Ebenstein, LLP
90 Park Avenue
New York, NY 10016-1301
crothste@arelaw.com

Date: 4-2-11

By: Mary T. Boesenhofer
Mary T. Boesenhofer

EXHIBIT B

BACHMANN INDUSTRIES, INC.,	:	
	:	
Petitioner,	:	
	:	
v,	:	Cancellation No.: 92053426
	:	
SCIENTIFIC TOYS, LTD.,	:	
	:	
Respondent.	:	
	:	

Petitioner, Bachmann Industries, Inc. (“Bachmann”) by counsel, serves the following responses to Respondent’s First Set of Interrogatories.

Bachmann objects to Respondent's First Set of Interrogatories to Petitioner on the grounds that the interrogatories exceed the numerical limit. *See* 37 CFR § 2.10(d)(1).

Bachmann objects to Respondent's First Set of Interrogatories to Petitioner to the extent that it purports to seek information and documents protected by the attorney-client privilege, the attorney work-product doctrine, or any other applicable privilege or protection. Bachmann deems such privileged information as not intended to be with the scope of this Discovery. Bachmann objects to Respondent's First Set of Interrogatories to Petitioner to the extent that it purports to seek information beyond the requirement of the applicable federal and local rules of civil procedure. Bachmann further objects to the extent that this Respondent's First Set of Interrogatories to Petitioner seeks highly confidential, proprietary or trade secret information, and/or the production of such information without a protective order. Bachmann objects to this Respondent's First Set of Interrogatories to Petitioner to the extent that it seeks information not confined to the subject of the claim, the context of the claim, nor the time period of the claim.

Bachmann incorporates each of these General Objections, as applicable, into each of its specific objections below.

INTERROGATORY RESPONSES

1. For each request for admissions served concurrently herewith for which the response is other than an unqualified admission, set forth the following:
 - a. each fact providing the basis for the response;
 - b. the identity of all persons having knowledge of the factual basis for the response; and
 - c. the identity of all documents supporting the response.

RESPONSE: Bachmann objects to this interrogatory as it exceeds the numerical limit allowed by 37 CFR § 2.120(d)(1).

2. Identify the persons at Petitioner primarily responsible for the following:
 - a. sales of toy trains and accessories;
 - b. advertising and promotion of toy trains and accessories;
 - b. the filing and maintenance of U.S. trademark registrations; and
 - c. the decision to commence this proceeding.

RESPONSE:

- a. Walter B. Reece, Senior Vice President Sales & Marketing.
 - b. Douglas Blaine, Vice President of Marketing.
 - c. Edwin Winter, Senior Vice President Finance & Administration.
 - d. Edwin Winter and Douglas Blaine
3. Identify each mark in the Alleged Family of E-Z Marks.

AS TO RESPONSES TO INTERROGATORIES:
BACHMANN INDUSTRIES. INC

Dated: 7/18/11

By: Douglas Blaine

Douglas Blaine

Title: VP Marketing

AS TO OBJECTIONS

Date: 7/18/11

By: Roberta Jacobs-Meadway

Roberta Jacobs-Meadway, Esq.

Tashia Burch Henderson, Esq.

Eckert Seamans Cherin & Mellott, LLC

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ATTORNEYS FOR PETITIONER

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of Petitioner's Response and Objections To Respondent's First Set of Interrogatories was served on the attorney of record in this matter via electronic mail and Federal Express Overnight mail on the date indicated below.

Chester Rothstein
Amster Rothstein & Ebenstein LLP
90 Park Avenue
New York, NY 10016
crothste@arelaw.com

Date:

7/18/11

By:

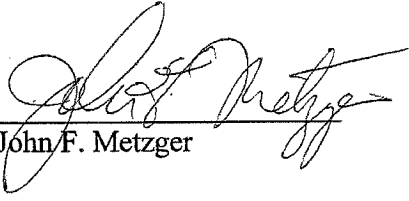

John F. Metzger

EXHIBIT C

US PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK AND APPEAL BOARD

- - -

BACHMANN INDUSTRIES, INC.,
Petitioner/Counterclaim Respondent,

Vs. CANCELLATION NO. 92053426

SCIENTIFIC TOYS, LTD.,
Respondent/Counterclaim Petitioner.

- - -

Oral deposition of DOUGLAS C. BLAINE,
taken at Eckert Seamans, Two Liberty Place, 50 South
16th Street, 22nd Floor, Philadelphia, Pennsylvania,
on Wednesday, October 26, 2011, beginning at
approximately 10:00 a.m., before Maureen E.
Broderick, Registered Professional Reporter and
Notary Public in and of the Commonwealth of
Pennsylvania.

JOB NO. 43266

Reported by: Maureen E. Broderick, RPR

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APPEARANCES

ECKERT SEAMANS

BY: ROBERTA JACOBS-MEADWAY, ESQUIRE

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Counsel for Petitioner/Counterclaim

Respondent

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New York, NY 10016

Counsel for Respondent/Counterclaim

Petitioner

ALSO PRESENT: Bridget H. Labutta (morning session)

1 Douglas C. Blaine

2 A I'm estimating, but maybe eight years ago.

3 Q Approximately 2003?

4 A Approximately.

5 Q Are you familiar with the name Edwin

6 Winter?

7 A I am.

8 Q Who is Edwin Winter?

9 A He's our senior vice president of finance.

10 There's more to his title, but that's essentially

11 it.

12 Q Is he involved in enforcement, trademark
13 enforcement activities?

14 A Yes.

15 Q In what way?

16 A He would be -- he would give his okay to
17 pursue a case against someone who is infringing.

18 Q Now, when you say "give his okay to pursue
19 a case," is that from a monetary point of view or
20 from a commercial point of view?

21 A A little bit of both, but primarily
22 financial.

23 Q Who at Bachmann is currently involved in
24 the decision as to when to file trademark
25 applications?

1 Douglas C. Blaine

2 A Only in photos in relation to this case.

3 Q Do you recall when you first heard of
4 Scientific Toys' use of its trademark EZ-Tec?

5 A Only in relation to this case.

6 Q When you say "in relation to this case,"
7 when in relation to the case? Before the case was
8 started or now that you're here for the deposition?

9 A Just before the case would have been
10 initiated.

11 Q Now, Interrogatory 2D in Blaine Exhibit 2
12 identifies you and Mr. Winter as being primarily
13 responsible for the decision to commence this
14 cancellation proceeding; is that correct?

15 A Where are we?

16 Q 2D, Page 2, Interrogatory 2.

17 A Okay, got it.

18 Q D as in David.

19 A Yes.

20 Q Did either Mr. Winter or you have more of
21 an impact on the decision to commence this suit?

22 A I don't -- I don't know what the -- what's
23 one more than the other.

24 Q I misspoke. It's not a suit, it's a
25 proceeding.

1 Douglas C. Blaine

2 Did you and Mr. Winter have
3 discussions before this proceeding was commenced?

4 A Yes.

5 Q Did you also have discussions with
6 counsel?

7 A I don't believe so.

8 Q When you and Mr. Winter had your
9 discussions about commencing this proceeding, who
10 else was present?

11 A I don't remember.

12 Q Other business people?

13 A I don't remember.

14 Q Were lawyers present?

15 A Oh, no.

16 Q What were the nature of your discussions,
17 the discussions between you and Mr. Winter prior to
18 the commencement of this proceeding?

19 A Just whether or not we should go forward
20 with it.

21 Q Why did you decide to go forward?

22 A We felt it was infringing upon our
23 trademark.

24 Q Prior to this meeting with Mr. Winter
25 where you decided that Scientific Toys was